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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,014	06/22/2001	John Timms	821-86	8045

7590 02/09/2005

Bhupinder S. Randhawa
Bereskin & Parr
Box 401
40 King Street West
Toronto, ON M5H 3Y2
CANADA

EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/886,014

Applicant(s)

TIMMS ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Note Regarding Examination

As required by MPEP 2144.03(C), it is noted that in the previous office action, certain subject matter was deemed old and well known in the art. Since any traversal of this assertion is required to be made in the response to the office action and since no traversal was made, those statements are considered to be admissions of prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al (6,507,352) in view of Brewaeys et al (4,408,693).

Cohen shows stocking numerous items at a retail outlet, each being identifiable by a visible retail location identifiers comprising e.g., aisle and shelf location; providing consumers with access to a computer programmed with merchandising software having a user interface for receiving input and displaying icons describing the items and displaying the retail location identifiers; and allowing consumers public access to the items. Cohen does not show that the items comprise fasteners. Brewaeys shows selling fasteners. It would have been obvious to one of ordinary skill in the art to modify the

method of Cohen by selling fasteners in order to provide a wider array of items for sale to the customer.

As to claims 3 and 39, Cohen in view of Brewaeys shows fasteners stocked in predetermined containers, identifiable by the visible container identifiers comprising the fasteners visible in the pack, the container identifiers being displayed on the user interface.

As to claim 3, Cohen in view of Brewaeys shows that the icons include images of the fasteners.

As to claim 4, Cohen in view of Brewaeys show all elements of the claim including organizing according to item type (in view of Brewaeys meaning fastener type), and that user input determines the display of the pages.

As to claim 5, Cohen in view of Brewaeys show a screen for displaying videos demonstrating the use of at least some fasteners.

As to claim 6, Cohen in view of Brewaeys show a touch screen and that (b) is carried out at the store.

As to claims 7-10, Cohen in view of Brewaeys show all elements of the claims except carrying out step (b) remote from the retail outlet via a network browser.

However, to do so is notoriously old and well known in the art. It would have been obvious to further modify the method of Cohen in order to facilitate comparison by the shopper in his home.

(Regarding claim 8 above, it is noted that in providing access to the software at a server via a network as in claim 9, the software is being provided to the customer on a pre-recorded medium, the server hard drive).

Alternatively, Cohen in view of Brewaeys shows all elements of claim 8 except physically giving the customer the software via a pre-recorded medium, such as a floppy disk. However, to distribute software in this manner is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to take advantage of simple, inexpensive and readily available technology and to allow the customer to select the items at his leisure in his home.

Claims 11-13, 14, 16, 17 and 30-37 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cohen et al.

It is noted that claims 11-17 were interpreted as an apparatus since a system per se is not defined per 35 USC 101. In so interpreting, it is noted that mere information stored on the apparatus is not a limitation on the apparatus.

Further, it is noted that clauses such as "for receiving" and "for selecting" are interpreted as intended use.

Cohen shows a computer having a user interface; a collection of web pages being displayed on the user interface including selection pages and detail pages and having icons for selecting different types of items and wherein each detail page includes item information; and display software.

Alternatively, Cohen shows all elements as discussed above, but does not show that the items are fasteners. However, it is notoriously old and well known in the art to sell fasteners. It would have been obvious to one of ordinary skill in the art to do so in order to widen the array of products available to the customer.

As to claims 14, 16 and 17, it is noted that these claims recite elements of the information stored on the apparatus only, and not limitations of the apparatus.

As to claim 30, Cohen shows all elements of the claim, or in the alternative shows all except that the items are fasteners, as discussed above regarding the apparatus.

As to claims 31-34, Cohen (or in the alternative Cohen in view of the well known prior art) shows all elements.

As to claims 35 and 36, Cohen shows all elements except providing real time stock information. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method of Cohen by providing real time stock information in order to save wasted trips to retrieve items.

As to claim 37, as broadly claimed Cohen shows that the database is stored remotely.

Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (5,283,865) in view of Brewaeys et al.

Johnson identifying an application in which an item can be used; accessing a collection of pages by a computer, the pages describing the items; navigating through the pages to identify a particular item suitable for the application; and choosing the appropriate item. Johnson does not explicitly show that the items comprise fasteners. Brewaeys shows selling fasteners. It would have been obvious to one of ordinary skill in the art to modify the method of Johnson as taught by Brewaeys in order to provide a broader array of parts that a customer might need.

As to claim 19, Johnson in view of Brewaeys show accessing an overview main page that illustrates two or more groups; selecting a type or group; viewing another page illustrating items with the type; and viewing the detailed page.

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Brewaeys et al as applied to claims 18 and 19 above, and further in view of Cohen et al.

Johnson in view of Brewaeys shows all elements of the claim except showing location information. Cohen shows providing stock locations. It would have been obvious to one of ordinary skill in the art to further modify the method of Johnson by providing stock location in order to ease finding the part.

As to claims 21 and 22, Johnson in view of Brewaeys and Cohen et al show all elements of the claim except providing real time stock information. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of

ordinary skill in the art to further modify the method of Johnson by providing real time stock information in order to save wasted trips looking for items.

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen et al in view of Brewaeys et al.

Cohen shows all elements of the claims except comparing the types of fasteners with a sample. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the arts to modify the method of the claim by doing so in order to ensure getting a similar fastener to the sample.

The examiner notes that he has personally performed this iterative comparison to a sample fastener prior to the application date.

Claims 1-15, and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (6,587,835) in view of Brewaeys et al (4,408,693).

Treyz shows stocking numerous items at a retail outlet, each being identifiable by a visible retail location identifiers; providing consumers with access to a computer programmed with merchandising software having a user interface for receiving input and displaying icons describing the items and displaying the retail location identifiers; and allowing consumers public access to the items. Treyz does not show that the items comprise fasteners. Brewaeys shows selling fasteners. It would have been obvious to one of ordinary skill in the art to modify the method of Treyz by selling fasteners in order to provide a wider array of items for sale to the customer.

It is noted that Treyz et al in view of Brewaeys et al shows all elements of claims 2-6.

As to claim 7, Treyz et al in view of Brewaeys et al show performing (b) remote from the particular retail outlet.

As to claims 9 and 10, Treyz et al in view of Brewaeys et al show all elements.

As to claim 11, Treyz et al in view of Brewaeys et al show all elements of the apparatus.

As to claims 12-15, all elements are shown.

As to claim 18, Treyz et al show identifying an application for an item (since applications such as "photography" and "video"); accessing a collection of pages by using a computer; navigating through the pages to find a particular item for the application; and choosing the item. Treyz et al do not show that the items is a fastener. Brewaeys et al show selling fasteners. It would have been obvious to one of ordinary skill in the art to modify the method of Treyz by providing for the sale of fasteners in order to facilitate greater selection for the customer.

As to claim 19, Treyz shows accessing an overview page; selecting a type; viewing another page of items of that type, as necessary; and viewing a detail page.

As to claims 20-24, Treyz et al in view of Brewaeys et al show all elements of the claims.

As to claim 25, Treyz et al in view of Brewaeys et al show going to the location of the item and purchasing the item.

As to claim 26, Treyz et al in view of Brewaeys et al show using a networked browser.

Response to Arguments

Applicant's arguments filed 11/3/2004 have been fully considered but they are not persuasive.

Applicant argues that the combinations between the primary references and Brewaeys are improper because motivation is lacking. The examiner respectfully disagrees. Motivation was explicitly provided in the rejection – to enable a broader array of products to be sold. To endeavor to provide a broader array of merchandise is well known. For instance, the advantage of doing so are mentioned in published patent application 2003/0036980 and U.S. Patent 6,029,153.

Applicant further argues that Brewaeys is non-analogous art. The examiner respectfully disagrees. The area of endeavor of the reference is a method of and apparatus for retailing numerous varieties of different types of fasteners, such as spikes and screws.

Applicant further argues that “numerous varieties” are not shown. As interpreted by the examiner, the disclosure of spikes and screws provides for numerous varieties.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding claims 11 and 30, it is noted that an apparatus is claimed. The disembodied collection of pages and the information they contain are not an element of the apparatus and therefore are not limiting on the apparatus. It is further noted that the claim was rejected alternatively, considering the pages and modifying the base reference to show that the items on the pages are fasteners.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER